

Serial No. 10/840,137
Art Unit: 1713

Remarks

Claims 1-14 are currently pending in the above-captioned matter. Claims 2 and 3 have been amended hereby and new claims 15-17 have been added. Support for the amendment is found in original claims 1, 2 and 14; page 2, line 20-24; and page 4, line 14 – page 5, line 5. After entry of the amendment claims 1-17 are pending in this application, claims 1 and 15 are independent. Remarks made herein are based on the claims as amended hereby.

35 USC §112 Rejections

Claims 1-14 were rejected under 35 USC §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 3 have been amended to clarify what applicant regards as the invention. Applicants respectfully traverse this rejection with respect to the claims as amended hereby.

With regard to claim 1, Applicants submit that the Patent Office has not established that one of ordinary skill in the pertinent art would not have been able to ascertain the particular area circumscribed by the claims and has therefore failed to establish a *prima facie* case of indefiniteness required under 35 U.S.C. §112, second paragraph. The Board of Patent Appeals and Interferences has stated:

In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims ***in light of the supporting specification***, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex Parte Wu*, 10 USPQ2d 2031, 2033 (Bd Pat App & Int 1989) (emphasis added).

One of ordinary skill in the art would recognize from a reading of claim 1, in light of the supporting specification, that an “effective temperature to remove paint” is the temperature wherein the composition is effective to remove the paint at an acceptable

Serial No. 10/840,137
Art Unit: 1713

rate. Applicants respectfully submit that one of ordinary skill, with knowledge of typical cleaning temperatures and times considered to be acceptable in the industry and those disclosed in the specification, would be able to ascertain with a reasonable degree of precision and particularity the area circumscribed by the claims. It is respectfully requested that the rejection of claim 1 under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim 2 has been amended to clarify that the ammonium salts recited are examples of the Markush group member "acid groups.....and salts thereof" recited in claim 1. Applicants believe that with this clarification the rejection has been obviated and should be withdrawn.

Claim 3 has been amended to correct what appears to have been a clerical error in that the term should have been "acid functional equivalent weight", which is discussed at page 4, line 14 – page 5, line 5. Applicants respectfully submit that the use of this term would be understood by one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, and the skilled artisan would have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. It is requested that the rejection be withdrawn.

35 USC §102 Rejections

Claims 1, 3-5, 7, 10 and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Bergishagen et al. (US 5,443,748). Applicants respectfully traverse the rejection. As the Office is no doubt aware, a rejection under 35 U.S.C. §102 can only be maintained if a single reference teaches each and every element of the claims. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Applicants independent claim 1 is directed to a method for flushing uncured

Serial No. 10/840,137

Art Unit: 1713

solvent-based paint from a paint delivery installation comprising contacting the paint with a composition comprising one or more organic solvents and at least one polymer dissolved in the solvent. The '748 does not teach or suggest using dissolved polymer as part of the cleaning composition or process. Instead, the '748 patent teaches cleaning with a polymer in particulate form, see '748 patent, col. 3, line 51-57.

According to the '748 patent, polymer is initially dissolved in solvent by heating and then is cooled to precipitate the polymer as insoluble particulate gel. These insoluble particles of polymer are used to clean paint lines. "After the entire amount of the mixture has been passed through the system and evacuated therefrom, cleaning the system, a solvent rinse is passed through the system." The particles are made soluble, by the solvent rinse, in order to get them out of the paint system. See, '748 patent, col. 4, line 43-68. This is not the process claimed by Applicants and withdrawal of the 35 U.S.C. §102 rejection of independent claim 1 and the claims depending therefrom is requested.

With regard to claim 3 and claim 13, the Patent Office has taken the position that "the limitations are inherent properties of the composition". Claim 3 recites "at least one polymer has an acid functional equivalent weight of greater than 300 g/mole". Claim 13 states that the "polymer has a number average molecular weight of at least 500". These are properties which identify selected polymers to be used in a composition according to the invention. Applicants submit that the acid functional equivalent weight or molecular weight of a polymer are inherent properties of that polymer, but are not inherent features of a composition made from these polymers. The acid functional equivalent weight or molecular weight of a polymer are features similar to whether, for example, the polymer is an acrylic or an epoxy. The choice of polymer selected for use in the composition is not an inherent feature of the composition, since other polymers could be used.

Neither the '748 patent nor Waldmann et al. (U.S. 5,294,352) teach or suggest selecting polymers for use in a composition according to the invention which meet the

Serial No. 10/840,137
Art Unit: 1713

features recited in claims 3 and 13. The '748 patent is silent regarding acid functional equivalent weight and number average molecular weight of the polymers used. Likewise, the '352 patent is silent regarding acid functional equivalent weight. Thus, the '748 patent and the '352 patent do not unambiguously teach or suggest the acid functional equivalent weight or the number average molecular weight of the polymers used therein and cannot anticipate Applicants' claimed method using these substances. Applicants therefore request that the rejection of claims 3 and 13 under 35 U.S.C. §102 be withdrawn.

35 USC §103 Rejections

Claims 6 and 8-9 are rejected under 35 U.S.C. 35 U.S.C. §103(a) as being unpatentable over Bergishagen et al (US 5,443,748). This rejection is traversed. The arguments made above, with respect to the 35 U.S.C. §102 rejection based upon the '748 patent, are incorporated herein by reference.

In order to support a rejection under 35 U.S.C. §103, the Office must establish that there was some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Office may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski* 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

With respect to claims 6 and 9, Applicants submit that there is no teaching or suggestion in the art of record of the desirability of combining four different organic solvents in particular quantities to achieve the invention claimed therein. Specifically, the '748 patent teaches that the quantity of polymer can be as high as 20 wt% and that

Serial No. 10/840,137
Art Unit: 1713

the remaining 80-99.9% is organic solvent. Nothing in either reference provides any motivation to select the particular types and amounts of organic solvent recited in claims 6 and 9. The modification of the '748 patent in an attempt to achieve claims 6 and 9 is not obvious unless the prior art also suggests the *desirability* of such modification, which is absent in this case. Applicant respectfully requests that the 35 U.S.C. §103 rejection of claims 6, 8-9 be withdrawn.

Claims 2, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergishagen et al (U.S. 5,443,748) in view of Waldmann et al. (U.S. 5,294,352). Applicants respectfully traverse the rejection. The arguments made above, with respect to the 35 U.S.C. §102 rejection based upon the '748 patent, are incorporated herein by reference. The '352 reference fails to remedy the defects of the '748 reference, which are recited above.

The '352 reference is directed to polymer adducts for use in "waterborne waste and lacquer paint treatment", Col. 6, line 26-29. The solvent systems taught by the '748 reference include organic, and organic solvent in an aqueous base: "The solvent carrier or vehicle comprising the remainder of the composition may be an organic or a combination of organic solvents, or a combination of organic solvents in an aqueous base depending upon the particular cleaning task.", Col 4, line 1-5.

There is no teaching or suggestion of a composition comprising less than 5 wt% water in the '748 patent, except the completely non-aqueous organic solvent/polymer composition. The '352 patent is directed to polymers usable in aqueous systems such as waste water and paint spray booth water. There is no motivation for one of skill in the art to use the polymers of the '352 patent in the non-aqueous compositions of the '748 patent. The '352 reference teaches use of its polymers in waterborne waste treatment. Thus, the '352 patent teaches away from a combination of its polymers with an organic solvent system. There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching,

Serial No. 10/840,137
Art Unit: 1713

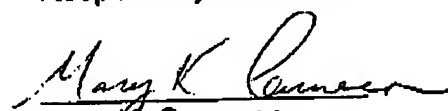
suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

One of ordinary skill in the art, upon reading the two references would be more likely to have been motivated to use the polymers of the '352 patent in the "organic solvent in an aqueous base" compositions of the '748 patent, where the intended use of the '352 polymers is in aqueous systems. This alternative combination, if even possible, would not achieve Applicants' Invention where the amount of water in all of the claims is less than 5 wt%. Accordingly, Applicants respectfully request that all of the rejections under 35 U.S.C. §103 be withdrawn.

Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned

Respectfully submitted,


Mary K. Cameron
(Reg. No. 34,789)
Attorney for Applicants
248-589-4672

Henkel Corporation
Patent Law Department
2200 Renaissance Boulevard, Suite 200
Gulph Mills, PA 19406